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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,678	06/25/2003	Dennis R. Feller	046295/264122	3756

826 7590 04/26/2004

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EXAMINER

DENTZ, BERNARD I

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/603,678

Applicant(s)

FELLER ET AL.

Examiner

Bernard Dentz

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.  
4a) Of the above claim(s) 4, 19 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-18, 20-35 and 37-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1,2,4-8,18,19,21-25,35,36 and 38-42, drawn to subject matter where both R4 and R5 are OH, classified in class 546, subclass 150 e.g.
- II. Claims 1,3-18,20-35 and 37-42, drawn to subject matter wherein one and only one of R4 and R5 is OH, classified in class 514, subclass 307 e.g..
- III. Claims 1,4-8,18,21-25,35 and 38-42, drawn to subject matter where neither of R4 or R5 is OH, classified in class 546, subclass 150 e.g..
- IV. Claims 1-9,18-26 and 35-43, drawn to subject matter wherein a 2,2-bis (alkoxycarbonyl)dioxolanyl group is part of compound's structure, classified in class 546, subclass 90 e.g..

The inventions are distinct, each from the other because: The di-hydroxy containing compounds have a separate place in the art from the mono-hydroxy compounds. The same is true of both of these relative to the non-hydroxy compounds. Finally the compounds where 2 of the ortho R groups are form a fused ring are patentably distinct also.

Because of the above and the different searches the above restriction is proper.

During a telephone conversation with Mr. Humphrey on 4-20-2004 a provisional election was made with traverse to prosecute the invention of Gp. II, claims 1,3-18,20-35 and 37-42. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2, 19 and 36 and the non-elected subject matter from the other

claims is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-18, 20-35 and 37-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The non-elected subject matter should be canceled from the claims.

Applicants should provide a PTO-1449 citing the references cited in the parent case. Although the application papers state that one was sent in it doesn't appear in the record. The examiner has a copy of these references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard Dentz whose telephone number is 571-272-0683. The examiner can normally be reached on Mon-Fri from 8AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached on 571 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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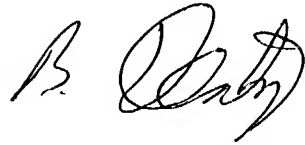
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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B. Dentz

4-20-2004

A handwritten signature in black ink, appearing to read 'B. Dentz', written in a cursive style.

BERNARD DENTZ  
PRIMARY EXAMINER  
GROUP 1630